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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,994	03/11/2004	Tadd H. Giles	13768.783.75	5167
47973 7590 10/28/2008 WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111				
EXAMINER				
ZHANG, SHIRLEY X				
ART UNIT		PAPER NUMBER		
2444				
MAIL DATE		DELIVERY MODE		
10/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,994

Applicant(s)

GILES ET AL.

Examiner

SHIRLEY X. ZHANG

Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 13, 16 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 16 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 4, 13, 16 and 35-40 were previously.

Claims 35 and 36 have been amended;

Claims 4, 13, 16 and 35-40 are now pending;

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application on August 25, 2008 after a final rejection was mailed on July 2, 2008. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 25, 2008 has been entered.

Response to Amendment

2. Applicant's arguments and amendments filed on April 8, 2008 have been carefully considered. The examiner's response can be found below in the "Claim Rejections" section.

Applicant has amended claims 35 and 36 to address issues raised by Examiner in the Final Rejection mailed on July 2, 2008.

However, the new amendments do not place the application in the condition for allowance because they do not sufficiently show that the claimed invention is unobvious to try, or produce unexpected results. Results of Examiner's prior art search show that at the time the

invention was made, a significant number of systems/methods have been invented to apply filtering criteria to data synchronization systems such as electronic message synchronization systems. Methods have also been invented to selectively apply filtering criteria to data records to be synchronized in order to improve synchronization speed and reduce synchronization time.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 4, 13, 16 and 35-40** are rejected under 35 U.S.C. 103(a) as being obvious over **Kennedy** (U.S. Patent No. 6,134,582) in view of **Ingraham et al.** (U.S. Patent No. 7,024,430, hereinafter “**Ingraham**”).

Regarding claim 35, Kennedy disclosed in a computing network comprised of a plurality of interconnected servers for transferring messages among the interconnected servers (column 2, lines 40-41 disclosed a system for managing messages in a client-server environment), and wherein at least some of the servers use a communication protocol that is not configured for communicating filtering information to the server (column 8, line 54 disclosed a POP3 server; the POP3 protocol does not support communication of filtering information to the server), and wherein the computing network also comprises a plurality of client side computing devices for accessing the servers and downloading messages (Fig. 1 and column 7, lines 10-12 disclose a plurality client devices 11a, 11b and 11c), a method of using client-side tracking

mechanisms to allow a client side computing device to efficiently determine which messages need to be downloaded from the at least some servers for filtering at the client side computing device, so that essentially most of the filtering operations occur before the messages are downloaded (Figs. 4a-4k), the method comprising:

setting at a client side computing device a filter criteria for new messages (column 3, lines 4-7 disclose that the step of downloading a message from the server to the client can include determining whether a size restriction has been set for downloading the message, where setting a size restriction is an example of setting a filter criteria);

receiving at a client side computing device a list that identifies the messages maintained at at least one server using a communication protocol that is not configured for communicating filtering information to the server (column 10, lines 5-22 disclose that the client 20 transmits a UIDL, TOP or LIST command to the server to request for identification information associated with a message; In the POP3 protocol, each of these commands may also request for identification information associated with a list of messages);

retrieving at the client side computing device a message store table that contains records identifying messages that have previously met the filter criteria, and marking each record with a flag (Figs. 4a-4k; column 9, lines 45-48 disclose that Figs. 4a-4k illustrates a client-based database for archiving messages, and marking each message with flags such as "On server", "Download", and "Delete");

retrieving at the client side computing device a table that contains records identifying messages that have not previously met the filter criteria (Figs. 4a-4k illustrate the client based database table 39 that contains columns "Message Size" and "Download flag"; column 18, lines

14-19 disclose that the message size for a message can be populated in the message size field immediately after obtaining the list of message sizes at step 328 in Fig. 5c; by following the steps in Fig. 5c, one of ordinary skill in the art can conclude that the result of the process is a database table 39 that may contain message entries whose message size field is populated but the “Download” flag remains unchecked because the message is greater than the predetermined size limit, therefore is not downloaded, i.e., these entries identify messages that have not met the filter criteria of size restriction).

comparing the messages identified in the received list with the records contained in the message store table and the checked table (column 12, lines 21-40 disclose that an UIDL retrieved from the server is compared to each message entry in the database 39 to determine whether there is a match) and then downloading to an inbox at the client side computing device only those messages that do not already correspond to a record in the message store table (column 12, lines 59-60 disclose that each new message is downloaded into the local message store 38, which is equivalent to an inbox recited in the claim), so that download time is limited only to new messages (column 15, lines 52-54 disclose that an advantage of Kennedy’s invention is that messages that have already been downloaded from the server to the local message store are not downloaded again)

checking the new messages downloaded against the filter criteria, and either adding a new record to the message store table if the filter criteria is met (column 13, lines 27-28 disclose that after downloading new messages to the local message store 38, a “download” flag is set in a message entry of the database 39; in Kennedy, only new messages that meets the size restriction criteria are downloaded; see Fig. 5c and column 17, lines 35-50 for more information), or else

adding a new record to the checked table if the filter criteria is not met (As already addressed above, by considering the disclosure in column 18, lines 14-19, the result of the process described in Fig. 5c is a database table 39 that may contain message entries whose message size field is populated but the “Download” flag remains unchecked because the message is greater than the predetermined size limit, and therefore is not downloaded, i.e., these entries identify messages that have not met the filter criteria of size restriction); and

removing any remaining records with marked flags in the message store table and the checked table (column 15, lines 2-5 disclose that each message entry having an “on server” flag in a false state “F” is deleted from the database 39 because the associated message is no longer located on the server).

Kennedy did not explicitly disclose the following elements in the claim:

- a. a checked table that contains records identifying only those messages that have not previously met the filter criteria and marking each record with a flag;
- b. the message store table and the checked table are two distinct tables; and
- c. the marking and unmarking of records in the message store table and the checked table that is in the exact same sequence as described in the claim.

Regarding elements a and b above, Ingraham disclosed the concept of using a mapping table to store information indicating the last time that each data record in a dataset was synchronized with a data subset and which of the records of the dataset are included or excluded (i.e., filtered out) from the data subset (Ingraham, column 5, lines 12-16).

One of ordinary skill in the art would have been motivated to combine Kennedy and Ingraham because both disclosed data synchronization (Kennedy, “Abstract” and Ingraham, title and “Abstract”).

Therefore, at the time of the invention, it would have been obvious for one to modify Kennedy so that messages that have not met the filter criteria are explicitly identified using a table similar to the mapping table disclosed by Ingraham, to yield the predictable result of avoiding unnecessary synchronization of data records that do not meet filter criteria so that the synchronization operation is efficient (Ingraham, column 8, lines 36-65).

Regarding element c, Examiner asserts that marking and unmarking of records in data tables is a matter of implementation choice, and that Kennedy’s way of setting flags and fields in the database 39 can achieve the same result as what the application is claiming.

Claim 36 is a method claim that contains substantially the same limitations as claim 35.

Furthermore, claim 36 includes the limitation that the method is implemented by computer program product’s computer-executable instructions, which is anticipated by Kennedy’s disclosure in column 5, lines 55-67 of the exemplary operating environment for the invention, where the operating environment comprises programs that include routines, operating systems and application programs that are computer program product’s computer-executable instructions.

Therefore claim 36 is rejected under the same rationale as claim 35.

Regarding claim 37, the combination of Kennedy and Ingraham disclosed a method as defined in claims 35 or 36.

Kennedy further disclosed that the client side computing device includes a plurality of application programs running on the client side computing device (column 5, lines 21-67), and wherein one or more of the application programs may configured by a user to establish filtering criteria for message information handled by that particular application program (column 3, lines 5-7 disclose that the client device can set a size restriction for downloading messages).

Regarding claim 38, the combination of Kennedy and Ingraham disclosed a method as defined in claim 37.

Kennedy further disclosed that the client side computing device includes a message store managing component which allows each of the application programs to store and retrieve stored messages for that application program (column 4, lines 41-45).

Regarding claim 39, the combination of Kennedy and Ingraham disclosed a method as defined in claim 38.

Kennedy further disclosed that the client side computing device includes a plurality of transports configured to receive and transmit different types of messages (column 8, lines 45-50 disclosed IMAP, POP3, SMTP, MIME and HTML as different transports for receiving and transmitting messages).

Regarding claim 40, the combination of Kennedy and Ingraham disclosed a method as defined in claim 39.

Kennedy further disclosed that the messages may comprise any or all of the following kinds of messages: IMAP4, SMS, POP3, Active Sync, IM, and MMS (column 8, lines 45-50 disclosed IMAP, POP3, SMTP, MIME and HTML; applying the invention to other messages such as SMS, Active Sync, IM and MMS is an obvious variation).

Regarding claim 4, the combination of Kennedy and Ingraham disclosed a method of claim 35. Kennedy further disclosed wherein receiving the list that identifies the messages comprises issuing a UIDL command to a POP3 server and receiving a plurality of unique message identifiers in response (column 10, lines 5-22).

Regarding claim 13, the combination of Kennedy and Ingraham disclosed a method of claim 35.

Kennedy did not explicitly disclose that the filtering criteria comprise a time window.

However, Ingraham disclosed a system and method for synchronization of data records such as calendar event records that occur within the next week, i.e., a time window (Ingraham, column 4, and lines 57-60).

The rationale for combining Kennedy and Ingraham is the same as that provided above in the rejection of claim 35.

Regarding claim 16, the combination of Kennedy and Ingraham disclosed the method of claim 36 wherein receiving the list that identifies the messages comprises issuing a UIDL command to a POP3 server (column 10, lines 5-22).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIRLEY X. ZHANG whose telephone number is (571)270-5012. The examiner can normally be reached on Monday through Friday 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. X. Z./
Examiner, Art Unit 2444
10/22/2008

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444